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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,719	01/30/2004	Hidehiko Ogawa	P24494	6058
7055	7590	02/08/2006	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			LEE, TOMMY D	
			ART UNIT	PAPER NUMBER
			2624	

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

✓

<b>Office Action Summary</b>	<b>Application No.</b> 10/767,719	<b>Applicant(s)</b> OGAWA, HIDEHIKO	
	<b>Examiner</b> Thomas D. Lee	<b>Art Unit</b> 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This Office action is responsive to applicant's amendment filed November 9, 2005. Claims 1-33 are pending.

### ***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,742,769 (Lee et al., hereinafter Lee) in view of U.S. Patent 5,878,230 (Weber et al., hereinafter Weber).

Regarding claims 1-5 and 11-15, Lee discloses an image data communication apparatus connected to an image data source and to a network, and transmitting an e-mail to a receiving apparatus via the network, the e-mail including a mail from command and a mail message (column 7, lines 26-39), the image data communication apparatus comprising: a memory configured to store a mail address of at least one user (password and e-mail information associated with registered users stored in subscriber database (column 5, lines 4-6)); and a panel section configured to select the mail address of at least one user stored in the memory (in order to log in, a user enters the e-mail address and password for authentication (column 5, lines 7-15)); and a controller configured to set the mail address of the user into the mail message of the e-mail, whereby the mail address of the user set into the mail message of the e-mail can be utilized as a destination for a reply to the e-mail, the reply being sent from the receiving apparatus,

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or whereby a reply to the e-mail is returned to the mail address of the user (user's e-mail address copied into "reply-to" field (column 7, lines 36-40), enabling reply from receiving apparatus (column 7, lines 51-59)). The panel section comprises a personal computer connected to the image data communication apparatus and displaying an HTML document for storing the mail message of the user in the memory (PENTIUM®-based personal computer running on a 32-bit operating system such as Windows NT (column 3, lines 23-28)).

Lee does not disclose the transmission of image data attached to the e-mail. However, it is well known in the art that image data may be transmitted as an attachment to an e-mail message. It is common practice to transmit a document or a picture via e-mail by scanning the document or picture and attaching it to the e-mail, and in such a case the attached document is inherently converted into a format for e-mail transmission. By providing for the transmission of scanned image data as an attachment, a greater variety of image data can be transmitted for immediate reception at the receiving apparatus, and thus it would have been obvious to modify the teaching of Lee by providing a scanner for inputting image data so that the image data may be transmitted as an attachment to an e-mail message, as is well known in the art.

Base claims 1, 6 and 11 have been amended to indicate that the memory storing user mail addresses is within the image data communication apparatus. Applicant asserts that in Lee, the memory that stores user mail addresses (directory service 25, storage 30) is distinct and generally remote from a sender (user 10), and thus the memory storing user mail addresses is not within the image data communication

apparatus (page 14 of applicant's amendment). However, providing a memory for storing e-mail addresses within an image communication apparatus is well known in the art. For years, Internet image communication apparatuses have been provided with memory for storage of e-mail addresses that a user can access for transmitting image data to a recipient. It would have been obvious to one of ordinary skill that by providing a memory within the image communication apparatus, a user is able to accessing a desired destination e-mail address from among a small number of e-mail addresses frequently selected, for transmitting a message without having to contact a directory service, thereby saving time that would otherwise be taken up in contacting the directory service, and the cost that would otherwise be charged for using the service.

Base claims 1, 6 and 11 have also been amended to indicate that the mail address of the user is distinct from a mail address of the image data communication apparatus, and that a reply is returned to the mail address of the user, without being returned to the image data communication apparatus. Applicant asserts that Lee does not disclose this limitation, stating that in Lee, the sender sets a sender's e-mail address into a "Reply-to" field, and a reply is returned to the sender that transmitted the sending e-mail (pages 14-16 of applicant's amendment).

Weber discloses a method whereby, in a third-party addressing mode, a user can specify an address, to which a reply message is transmitted from a recipient (column 3, lines 59-63; column 5, lines 4-29). This is contrary to applicant's assertion that in Weber the sender sets a sender's e-mail address into an e-mail so that reply to the original message will be directed to the sender or originator, and thus Weber discloses

a conventional reply mail (pages 16-17 of applicant's amendment). If fact, Weber describes difference in operation between the conventional method (column 5, lines 4-12) and Weber's method of sending a reply message to a third party (column 5, lines 13-29).

One of ordinary skill would have recognized that a sender may want to direct responses to an e-mail message to a variety of third party recipients, as opposed to having the response directed back to him/her (Weber: column 3, lines 21-30). Therefore, it would have been obvious for one of ordinary skill in the art to modify the teaching of Lee by providing a means for returning a reply e-mail to an address indicated by a sender rather than to the sender, as disclosed in Weber.

Regarding claims 16, 17, 20 and 21, Lee further discloses a transmitter configured to transmit an e-mail to a receiving apparatus via the network, the e-mail including a mail from command and a mail message (column 7, lines 26-35).

Claims 22, 23, 26, 27, 28, 29, 32 and 33 are method claims corresponding to above-rejected apparatus claims 1, 5, 11, 15, 16, 17, 20 and 21, respectively. The method steps are suggested in Lee in view of Weber, as set forth above.

As for claims 6-10, 18, 19, 24, 25, 30 and 31, these claims differ from the above-rejected claims in that a reply to the e-mail can be sent to the user without requiring input of the mail address of the user at the receiving apparatus. Lee discloses the sending of a reply to the user, as mentioned above, but does not explicitly state that the user is not required to input the user's mail address. This limitation is disclosed in Weber (in known prior art system, a reply attribute is automatically generated, directing

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a reply to the sender or originator (column 3, lines 21-27)). Furthermore, in Weber the reply-to address designated by an original sender is automatically placed as the primary address field (column 5, lines 18-22). Thus a person receiving an e-mail message need not enter a user's e-mail address in the "to" field when replying to a message from the sender, thereby eliminating the possibility of entering the user's address incorrectly. Therefore, it would have been obvious for one of ordinary skill in the art to modify the teaching of Lee by providing automatic reply attribute generation, as disclosed in Weber.

### ***Response to Arguments***

4. Applicant's arguments filed in response to the rejection of claims 1-33 under 35 U.S.C. 103(a) as set forth in the prior Office action have been fully considered but they are not persuasive.

Applicant's arguments regarding the application of Lee and Weber individually to the claims (pages 14-17 of applicant's amendment) has been addressed above.

Applicant further asserts that the examiner has not set forth any proper evidentiary support for his assertion of obviousness of combining Lee and Weber, and submits that there is no proper motivation for the modification of the teachings of Lee by the teachings of Weber (page 18 of applicant's amendment). Contrary to applicant's assertion, it was stated in the prior Office action that one of ordinary skill in the art would have been motivated to combine Lee and Weber so that a person receiving an e-mail message need not enter the sender's e-mail address in the "to" field when replying to a message to the sender, thereby eliminating the possibility of entering the sender's

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address incorrectly (page 4 of prior Office action). Furthermore, proper motivation to combine is explicitly stated in Weber (column 3, lines 21-30).

***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Lee whose telephone number is (571) 272-7436. The examiner can normally be reached on Monday-Friday, 7:30-5:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas D. Lee  
Primary Examiner  
Art Unit 2624

tdl  
February 2, 2006